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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/763,067

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07/27/2006

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EXAMINER

DEVOTI, PAUL D

ART UNIT

PAPER NUMBER

3637

DATE MAILED: 07/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/763,067	<b>Applicant(s)</b> GABBARD ET AL.	
	<b>Examiner</b> Paul Devoti	<b>Art Unit</b> 3637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 17-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16, 27-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

3. Claim 9 (line 23) recites "the first offset distance is greater than the second and third offset distances". This limitation of the claim is not described in the specification.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 3637

6. Claim 1 recites the limitation "the shingle" in lines 6, 11, 12, 13, 14. There is insufficient antecedent basis for this limitation in the claim. Earlier references in the claim are made to a "shingle panel system" and "shingle assemblies".

7. Claim 1 recites the limitation "the first shingle panel" in line 15. There is insufficient antecedent basis for this limitation in the claim.

8. Claim 1 recites the limitation "the second shingle panel" in line 17. There is insufficient antecedent basis for this limitation in the claim.

9. Claim 1 recites the limitation "the third shingle panel" in line 22. There is insufficient antecedent basis for this limitation in the claim.

10. Claim 1, lines 28-33, repeats the limitations in lines 22-27, and this double inclusion renders the claim indefinite.

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

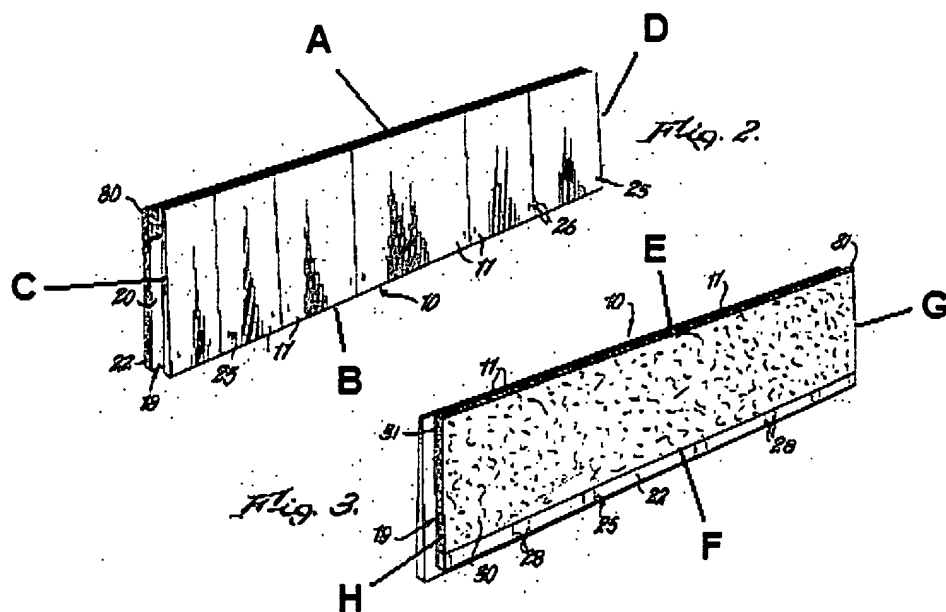
12. Claims 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fink et al. (US 3095671) in view of Peebles (US 2151794).

13. Regarding claims 9 and 11, Fink discloses a shingle panel with a plurality of shingles (11), and each shingle (11) having a first edge (A), second edge (B), third edge

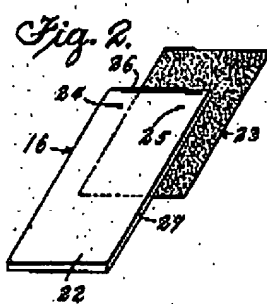
Art Unit: 3637

(C), and a fourth edge (D), where the first edge (A) is opposite the second edge (B) and the third edge (C) is opposite the fourth edge (D). Additionally, at least one backing (30) is affixed to the shingles, where the backing has first edge (E), second edge (F), third edge (G), and fourth edge (H), where the first edge (E) is opposite the second edge (F) and the third edge (G) is opposite the fourth edge (H). Additionally, the first edge (E) of the backing (30) is substantially aligned with the first edge (A) of the shingles, the second edge (F) of the backing is offset from the second edge (B) of the shingles forming a first offset distance, the third edge (G) of the backing is offset from the third edge (C) of the shingles forming a second offset distance, and the fourth edge (H) of the backing is offset from the fourth edge (D) of the shingles forming a third offset distance. The distance between the third and fourth edges (G, H) of the backing, when measured, is substantially the same as the distance between the third and fourth edges (C, D) of the plurality of shingles.

14. Fink does not disclose the first offset distance is greater than the second and third offset distances. Peebles, however, discloses a shingle (16) with a backing (23) that is offset from the shingle (as seen in Figure 2), having a first offset distance that is greater than a second and third offset distance. Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to modify Fink's shingle panel to include a first offset distance that is greater than a second and third offset distance as shown by Peebles, as this would help in the installation of the shingle panel with adjacent panels.



Fink et al. (US 3095671) Figures 2 and 3



Peebles (US 2151794) Figure 2

15. Regarding claim 10, Fink in view of Peebles discloses everything previously mentioned, including the distance between the first and second edges (E, F) of the

Art Unit: 3637

backing is less than the distance between the first and second edges (A, B) of the shingles.

16. Regarding claim 12, Fink in view of Peebles discloses everything previously mentioned, including the backing (30) is affixed to the shingles by glue (Column 3, line 59-63).

17. Regarding claim 13, Fink in view of Peebles discloses everything previously mentioned, including at least one of the plurality of shingles (11) has a thickness and the thickness is tapered from the second edge (B) to the first edge (A) of the shingle.

18. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fink et al. in view of Peebles (US 2151794) and further in view of Mendez (US 4651492)

19. Regarding claim 14, Fink in view of Peebles discloses everything previously mentioned, but does not teach at least one groove extending between the first edge and second edge of the shingle. Mendez, however, discloses a shingle with a groove (50) extending between a first edge (28) and second edge (22). Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to modify Fink's shingle panel, already modified by Peebles, to include a shingle with a groove extending substantially between the first edge and second edge of the shingle, as taught by Mendez, to allow water to quickly run off the shingle.

Art Unit: 3637

20. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fink et al. in view of Peebles (US 2151794) and further in view of Cumfer (US 1534165).

21. Regarding claims 15 and 16, Fink in view of Peebles discloses everything previously mentioned, but does not disclose that the backing comprises at least one breathing groove substantially parallel with the third and fourth edges of the backing, and at least one groove extends from the first edge of the backing. Cumfer, however, discloses a backing of a shingle (10) with a groove (16) that extends from the first edge and is substantially parallel with the third and fourth edges. Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to modify Fink's shingle panel, already modified by Peebles, to include a groove extending from the first edge of the backing and substantially parallel with the third and fourth edges, as taught by Cumfer to make the shingle more durable and the resulting roof more weather resistant.

22. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fink et al. (US 3095671) in view of Utley (US 108068).

23. Regarding claim 1, Fink discloses a shingle panel with a plurality of shingles (11), and each shingle (11) having a first edge (A), second edge (B), third edge (C), and a fourth edge (D), where the first edge (A) is opposite the second edge (B) and the third edge (C) is opposite the fourth edge (D). Additionally, at least one backing (30) is



Art Unit: 3637

affixed to the shingles, where the backing has first edge (E), second edge (F), third edge (G), and fourth edge (H), where the first edge (E) is opposite the second edge (F) and the third edge (G) is opposite the fourth edge (H). Additionally, the first edge (E) of the backing (30) is substantially aligned with the first edge (A) of the shingles, the second edge (F) of the backing is offset from the second edge (B) of the shingles, the third edge (G) of the backing is offset from the third edge (C) of the shingles, and the fourth edge (H) of the backing is offset from the fourth edge (D) of the shingles.

24. Figure 1 of Fink shows a first shingle panel affixed to a building exterior, and a second shingle panel positioned relative to the first shingle panel so that the first edges (A) of the panels are aligned. The third edge (C) of a second shingle panel abuts the fourth edge (D) of a first shingle panel. The offset of the third edge (C) of the second shingle panel interlocks with the offset of the fourth edge (D) of the first shingle panel. A third shingle panel is positioned with its second edge (B) overlapping the first edges (A) of the first and second shingle panels. Fink does not disclose the second edge (B) of the third shingle panel interlocks with the first edges (A) of the first and second shingle panels, so that the second edge (B) of the third shingle panel overlaps the first edge (A) of the first and second shingle panels substantially to the offset of the backing along the second edge of the third shingle panel.

25. Utley, however, discloses roofing tiles having a front section, and a back section offset from the front section. Figure 1 of Utley shows the bottom edge of a first tile interlocking with the top edge of additional tiles so that the bottom edge of the tile overlaps the additional tiles to its offset. Therefore, it would have been obvious to one

Art Unit: 3637

having ordinary skill in the art at the time of invention to modify Fink's shingle panel system to include shingles that interlock with shingles located below as taught by Utley, to provide a secure attachment for adjacent shingle panel assemblies.

26. Regarding claim 2, the distance between the first and second edges (E, F) of the backing is less than the distance between the first and second edges (A, B) of the shingles.

27. Regarding claim 3, the distance between the third and fourth edges (G, H) of the backing, when measured, is substantially the same as the distance between the third and fourth edges (C, D) of the plurality of shingles.

28. Regarding claim 4, the backing (30) is affixed to the shingles by glue (Column 3, line 59-63).

29. Regarding claim 5, at least one of the plurality of shingles (11) has a thickness and the thickness is tapered from the second edge (B) to the first edge (A) of the shingle.

30. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fink et al. (US 3095671) in view of Utley (US 108068) as applied to claim 1 above, and further in view of Mendez (US 4651492).

31. Regarding claim 6, Fink in view of Utley discloses everything previously mentioned, but does not disclose at least one groove extending between the first edge and second edge of the shingle. Mendez, however, discloses a shingle with a groove (50) extending between a first edge (28) and second edge (22). Therefore, it would

Art Unit: 3637

have been obvious to one having ordinary skill in the art at the time of invention to modify Fink's shingle panel, already modified by Utley, to include a shingle with a groove extending substantially between the first edge and second edge of the shingle, as taught by Mendez, to allow water to quickly run off the shingle.

32. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fink et al. (US 3095671) in view of Utley (US 108068) as applied to claim 1 above, and further in view of Cumfer (US 1534165).

33. Regarding claims 7 and 8, Fink in view of Utley discloses everything previously mentioned, but does not disclose that the backing comprises at least one breathing groove substantially parallel with the third and fourth edges of the backing, and at least one groove extends from the first edge of the backing. Cumfer, however, discloses a backing of a shingle (10) with a groove (16) that extends from the first edge and is substantially parallel with the third and fourth edges. Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to modify Fink's shingle panel, already modified by Utley, to include a groove extending from the first edge of the backing and substantially parallel with the third and fourth edges, as taught by Cumfer to make the shingle more durable and the resulting roof more weather resistant.

34. Claims 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fink (US 3095671) in view of Utley (US 108068).

Art Unit: 3637

35. Regarding claims 27 and 28, Fink in view of Utley discloses everything previously mentioned including all of the structural limitations, and the method recited in claims 27 and 28 would be an obvious method of using a shingle panel of Fink in view of Utley.

### ***Response to Arguments***

36. Applicant's arguments with respect to claims 1, 9, 27, and 28 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

37. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 3637

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Devoti whose telephone number is 571-272-2733. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 571-272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PD *PD*  
07/24/06

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